

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) FUJS 20.759 (100794-00510)	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number 10/729,817	
		Filed December 5, 2003	
		First Named Inventor Katsuaki Akama	
		Art Unit 3621	Examiner Evens J. Augustin

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.
 assignee of record of the entire interest.
 See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
 (Form PTO/SB/96)
 attorney or agent of record. 44071
 Registration number _____.
 attorney or agent acting under 37 CFR 1.34.
 Registration number if acting under 37 CFR 1.34 _____.

/Dexter T. Chang/

Signature

Dexter T. Chang

Typed or printed name

(212) 940-6384

Telephone number

November 17, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
 Submit multiple forms if more than one signature is required, see below*.

<input checked="" type="checkbox"/>	*Total of <u>1</u> forms are submitted.
-------------------------------------	---

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Attorney Docket No.: FUJS 20.759 (100794-00510)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Katsuaki AKAMA

Confirmation No.: 2105

Serial No.: 10/729,817

Filed: December 5, 2003

Title: ELECTRONIC TRANSACTION METHOD ...

Examiner: Evens J. Augustin

Group Art Unit: 3621

November 17, 2010

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

In connection with the Pre-Appeal Brief Request for Review submitted herewith and in response to the final Office Action dated August 17, 2010, Applicant requests a panel review to determine whether the Examiner has failed to properly establish bases for a § 103 rejection of pending claims 1, 3-9, 13-16, and 28 in the subject application. And, in support thereof, Applicant respectfully submits the following:

REMARKS

Claims 2 and 10-12 have been canceled without prejudice. Claims 1, 3-9, and 13-28 remain pending in the application, of which claims 17-27 have been withdrawn from consideration.

Claims 1, 3-9, 13-16, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,855,007 to Jovicic et al. in view of U.S. Patent No. 6,497,360 to Schulze, Jr. Applicant respectfully traverses the rejection.

Jovicic et al. merely describe

“After the transaction is recorded, the Internet Coupon Server 124 notifies the transaction 512 over the Internet Coupon ICNC gateway to the coupon owner’s ICNC 134 by first sending customer’s name 320, then customer’s identification number 322 and then the current coupon serial number 318.” Col. 9, lines 23-28 of Jovicic et al.

That is, Jovicic et al. only describe sending customer’s name 320 and so on. The Examiner conceded that Jovicic et al. fail to disclose ownership of an electronic coupon being transferred, and relied upon Schulze, Jr. as a combining reference that allegedly suggests such a feature. Page 4, lines 1-6 of the Office Action.

But, as Applicant demonstrated in the previous Response, Schulze, Jr. only describes reconciliation after coupon redemption and not actual ownership transfer between potential users of the coupon:

“Prior to or concurrent with payment to the retailer, ownership of such redeemed coupons is transferred from the retailer to the coupon verification personnel.” Col. 3, lines 53-55 of Schulze, Jr.

That is, Schulze, Jr. merely describes a redeemed coupon going from a retailer to coupon verification personnel.

Therefore, Schulze, Jr. is totally silent about changing ownership of an electronic coupon from one information terminal to another information terminal and the corresponding change in owner identification information, as claimed.

In response to Applicant's arguments, the Examiner maintained that Schulze, Jr. adequately suggested the claimed invention:

"However, Schulze describes an invention that relates to systems for accurately tracking the use of coupons redeemed by consumers, and for promptly reimbursing retailers for discounts extended to consumers in exchange for coupons presented to the retailer. According to Schulze, ownership of a coupon is transferred from entity to the next (C3, L53-57)." Page 6, lines 13-16 of the Office Action. (Emphasis added)

But as Applicant emphasizes above, Schulze, Jr. only describes reimbursing a retailer for coupons that have already been redeemed at the retailer. The coupon retains no value for ownership. And thus, the "ownership" being transferred back to coupon verification personnel merely refers to a physical transfer to expire the coupon, and not an ownership transfer to another entity that would be able to use the coupon:

"At step 524, the coupon verification personnel retrieve the redeemed coupons from the secure storage container, and enter coupon identifying information into the coupon redemption subsystem 104. The identifying information may be entered into the coupon redemption subsystem 104 by reading information from the coupons using the scanner 336 or a coupon reader that might be controlled to destroy (e.g. shredding), or otherwise render unusable, the coupon after it has been verified or accepted. Alternatively, identifying information may be entered manually, such as by using the keyboard 340. Information may be stored in the storage 304, and may include all of the identifying information encoded on the coupon, such as the face value, the product the coupon applies to, the expiration date of the coupon and information concerning the distribution method and/or recipient of the coupon."

Thus, the "ownership" transfer described in Schulze, Jr. only refers to a transfer of physical coupons between a retailer, at which the physical coupons have been redeemed, and

the third party verifier that verifies the coupons and reimburses the retailer. The only identification information in relation to the coupon is entered once at this verification, after which the coupon may be "destroyed" or "otherwise rendered unuseable." Schulze, Jr. only describe storing identifying information for redeemed coupons in the storage 304, and does not disclose or suggest any changes to the stored information of a particular coupon that has already been redeemed.

Accordingly, Schulze, Jr.—and correspondingly, the proposed combination of references—only describes recording information for a redeemed coupon and fails to disclose or suggest the claimed features in connection with changing identification information for an ownership transfer of a coupon.

In other words, even assuming, arguendo, that it would have been obvious to one skilled in the art at the time the claimed invention was made to combine Jovicic et al. and Schulze, Jr., such a combination would still have failed to disclose or suggest,

“[a]n electronic transaction method using an electronic coupon in an electronic transaction system comprising an electronic shop server opening an electronic shop site on Internet to operate and manage said electronic shop site, a coupon issuance/management server, which has a transfer management memory, issuing and managing an electronic coupon having pecuniary value information usable in a settlement of an electronic transaction for said electronic shop site, and a plurality of information terminals individually operable to access to said electronic shop and to access each other to carry out an electronic transaction, said electronic transaction method comprising:

requesting said coupon issuance/management server to issue said electronic coupon from one of said information terminals;

issuing, to said requesting information terminal having requested said electronic coupon by said coupon issuance/management server, said electronic coupon having said pecuniary value information and owner identification information related to said requesting information terminal;

recording and managing, by said coupon issuance/management server, said owner identification

information of said electronic coupon as coupon management information in the transfer management memory; and

changing, when said requesting information terminal transfers said electronic coupon to another information terminal, said owner identification information recorded in said transfer management memory from the owner identification information of said requesting information terminal to owner identification information of said another information terminal by said coupon issuance/management server,” as recited in claim 1. (Emphasis added)

Accordingly, Applicant respectfully submits that claim 1, together with claims 3-9, 13-16, and 28 dependent therefrom, is patentable over Jovicic et al. and Schulze, Jr., separately and in combination, for at least the above-stated reasons.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

/Dexter T. Chang/
Dexter T. Chang
Reg. No. 44,071

CUSTOMER NUMBER 026304
Telephone: (212) 940-6384
Fax: (212) 940-8986 or 8987
Docket No.: FUJS 20.759 (100794-00510)
DTC:tb